

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEFAN GOSS and DIETMAR KELL

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Appeal No. 2000-0235  
Application No. 08/765,502

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ON BRIEF

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Before FLEMING, RUGGIERO, and LALL, Administrative Patent Judges.  
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 11,12, 14 and 16-22, which constitute all the pending claims in the application.

According to appellants (brief at pages 2 and 3), the present invention relates to a device for providing information to a motor vehicle driver. The device includes a decoder for receiving and decoding digitally coded traffic messages, and an auto navigator for determining an instantaneous position of the vehicle and calculating route recommendations. The device include one data storage medium storing both a digitally coded road map and information necessary for decoding and

outputting the traffic messages. Figure 3 of the specification shows a storage medium with a first part 34 which contains information necessary to decode the traffic message, and a second part 35 which contains information for the voice alert. The first part 34 can be easily accessed by a decoding program. The following claim further illustrates the invention.

Claim 11. A device for informing a motor vehicle driver comprising:

a receiver for receiving and decoding at least one digitally coded traffic message;

an auto navigator for determining an instantaneous position of a vehicle and at least one route recommendation; and

only one data storage unit having a data storage medium for storing both a digitally coded road map and information needed for decoding and outputting the at least one traffic message;

wherein the receiver, the auto navigator and the data storage unit form a single structural unit.

The examiner relies on the following references:

Duckeck et al. (Duckeck)	5, 020,143	May 28, 1991
Kakihara et al. (Kakihara)	5,293,163	Mar. 8, 1994
Braegas	5,406,490	Apr. 11, 1995

Claims 11, 12, 14 and 17-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Braegas in view of Kakihara.

Claim 16 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Braegas in view of Kakihara and Duckeck.

Rather than repeat the arguments of appellants and the examiner we make reference to the brief (paper no. 13), reply brief (paper no. 15) and the examiner's answer (paper no. 14) for the respective details thereof.

### OPINION

We have considered the rejections advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellants' arguments set forth in the briefs.

We reverse.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness (see In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ 1443, 1445 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one ordinary skill in the art. (See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531, (Fed. Cir. 1993)).

Before establishing a prima facie case of obviousness, the examiner must interpret the scope of the claims because "[t]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

Appellants' claim 11, the only independent claim, recites the limitation of "only one data storage unit having a data storage medium for storing a digitally coded road map and information

needed for decoding and outputting the at least one traffic message”. The examiner recognizes (answer at page 4 and 5) that the primary reference, Braegas, does not disclose this limitation, however, the examiner asserts that Kakihara’s CD-ROM element 25a which is used for map storage could have been consolidated in a single memory medium to store both traffic decoding information and the map data. (Id. at page 5).

Appellants argue (brief at page 5) that “[i]n clear contrast to Appellants’ invention, the Braegas Patent and the Kakihara Patent, taken alone or in combination, in no way teach or suggest a device for informing a motor vehicle driver in which **only one data storage unit stores both a digitally coded road map and information needed for decoding and outputting at least one traffic message**, as clearly recited in independent claim 11.”

We agree with the appellants’ position. Like appellants, we find that element 25a of Kakihara is a read-only memory which cannot store any information that was not originally stored therein. Furthermore, we find that Kakihara does not contain any other information in the CD-ROM element 25 besides the road map information. In other words, element 25 of Kakihara does not contain or suggest the storing of any decoding information which might be accessed by the decoding program to output a traffic-modified route. See item 34 in Figure 3 and page 11 of the Appellants’ disclosure for a detailed explanation of the decoding information contained in the recited storage medium for the determining of the route as modified by the traffic conditions on the road. Therefore, we conclude that the examiner has not established a prima facie case of obviousness in rejecting claim 11 over Braegas and Kakihara.

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Since claims 12, 14 and 16-22 contain at least the recited limitations of claim 11, and Duceck (with respect to claim 16) does not cure the deficiency noted above, we do not sustain the obviousness rejection of these claims.

The decision of the examiner rejecting claims 11, 12, 14 and 16-22 under 35 U.S.C. § 103(a) is reversed.

REVERSED

MICHAEL R. FLEMING  
Administrative Patent Judge

JOSEPH F. RUGGIERO  
Administrative Patent Judge

PARSHOTAM S. LALL  
Administrative Patent Judge

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Appeal No. 2000-0235  
Application No. 08/765,502

***Letty***

JUDGE LALL

APPEAL NO. 2000-0235

APPLICATION NO. 08/765,502

APJ LALL

APJ FLEMING

APJ RUGGIERO

DECISION: **REVERSED**

**PREPARED:** Jul 18, 2003

**OB/HD**

**PALM**

**ACTS 2**

**DISK (FOIA)**

**REPORT**

**BOOK**